



PATENT CASE: CN01367X

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of: **STAMFORD et al.**

Examiner: Balasubramanian

For Patent: **HETEROARYL UREA
NEUROPEPTIDE Y Y5 RECEPTOR
ANTAGONISTS**

Date: February 28, 2003

Group Art Unit: 1624

Serial No.: 10/026,651

Filed: December 18, 2001
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Schering-Plough Corporation
Kenilworth, New Jersey 07033

Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the species election requirement mailed on January 29, 2003 for the above-identified application, applicants respond as follows.

Claims 1-31 are pending in the application. The Examiner restricted the claims into seven major groups:

Group I (claims 1-11, 21-31)

Group II (claims 1-4, 12-14 and 21-31)

Group III (claims 1-4, 15-16 and 21-31)

Group IV (claims 1-4, 17 and 21-31)

Group V (claims 1-4, 18 and 21-31)

Group VI (claims 1-4 and 19-31)

and

Group VII (claims 1-4, 15-16 and 21-31).

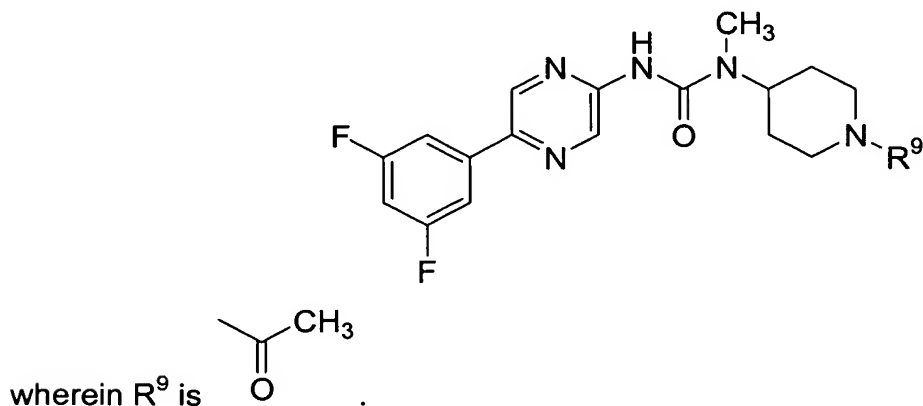
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The Examiner advised Applicants to elect a Group as well as a single compound to be examined and to identify the claims reading thereon.

Applicants are puzzled by the restrictions of the claims by the Examiner and believe that claims 1-31 form part of one and the same invention. Applicants believe that when there is a linking generic claim encompassing the scope of all the compounds, pharmaceutical compositions comprising them and methods of treatment using them, it is inappropriate to restrict the invention to a single compound. Applicants also believe that due to such commonality a complete examination of claims 1-31 would not cause undue burden. Applicants further believe that the same art search will most probably apply to the alleged separate inventions. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

However, for the sake of facilitation of prosecution and in order to comply with the Examiner's requirement, Applicants elect the claims that the Examiner has identified as belonging to Group II (claims 1-4, 12-14 and 21-31) with traverse.

Further, Applicants elect the following species (Example 10) belonging to the elected Group II with traverse:




The above-noted compound is the first compound shown in claim 12, page 105. Applicants believe that compound claims 1-4, 12-14, and the pharmaceutical

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composition and method of treatment claims 21-31 comprising the above-shown compound are readable on the above-shown compound.

The Examiner is requested to call the undersigned attorney on any matter connected with this application.

Respectfully submitted,



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WILLIAM LEE
(REGISTERED REPRESENTATIVE)

 2/28/2003
(SIGNATURE AND DATE)